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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,591	05/26/2000	Robert A. Levy	11819-002001	9499

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BOSTON, MA 02109-1808

EXAMINER
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WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/580,591	Applicant(s) LEVY, ROBERT A.4	
	Examiner Michael Y Won	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

1. Claims 1-35 have been re-examined and are pending with this action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1, 2, 10-13, 17, 20 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "market valuation" is not mentioned in the disclosure although the term "market value" is used in a plurality of locations within the disclosure. The claim should recite terminology consistent with the disclosure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-16, 18, 19, 21-25, and 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 5,963,914A) in view of Sanders (US 6,411,936 B1).

As per claims 1, 11, 12, 21, 28, 30, 32, and 34, Skinner teaches of a system, a method, and an apparatus comprising a computer-readable medium or memory that stores computer instructions and a processor (see col.9, line 52) that executes the computer instructions for implementing an application for obtaining information (see abstract: "data collector") about the work activities (see abstract: "time and work performed") of a plurality of employees (see col.3, lines 4-6), comprising: a server for providing a site through which each of the plurality of employees creates a profile of the work activities of the employee (see col.20, lines 35-45); and a computer capable of accessing the site over a network, each of the plurality of employees using the computer to create the profile of the work activities of the employee, and transmit the information about the work activities of the employee to the server (see col.2, lines 43-54 and line 67 to col.3, line 3).

Skinner does not explicitly teach wherein the server calculates a market valuation for the profile of the work activities of the employee including by correlating the work activities of the employees, percentages of time allocated to the work activities of the employees, and salary rates. Sanders teaches of calculating a market valuation for the profile of the work activities of the employee (see col.16, lines 14-18 and col.19, lines 10-14) including by correlating the work activities of the employees, percentages of time

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allocated to the work activities of the employees, and salary rates (see col.20, lines 31-39).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Sanders with the system of Skinner by implementing calculating market valuation within the work activity information obtaining system, method and apparatus because Sanders teaches that the market value of an employee assists in determining the "net value addition per person" within the enterprise and stresses that "intellectual capital" is becoming more important to the value of the company (see col.4, lines 10-21) and Skinner teaches that his "system is useful... for performance-based assessment testing" (see col.19, lines 17-23).

As per claim 2, Skinner does not explicitly teach wherein the server is capable of performing an analysis of the work activities of the employee based on the profile of the work activities of the employee and the calculated market valuation. Sanders teaches of performing an analysis of the work activities of the employee based on the profile of the work activities of the employee and the calculated market valuation (see col.19, lines 18-25). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Sanders with the system of Skinner by implementing performing an analysis of the work activities of the employee based on the profile of the work activities of the employee and the calculated market valuation within the work activity information obtaining system, method and apparatus because Sanders teaches that such analysis assists in enhancement of the enterprise value (see abstract).

As per claims 3, 13, 22, 29, 31, 33, and 35, Skinner further teaches wherein the server is capable of generating a report based on the work activities of the employee in the profile (see col.4, lines 54-61).

As per claim 4, Skinner further teaches wherein the network is a network known as the Internet (see col.5, lines 36-37).

As per claims 5 and 6, Skinner teaches of further comprising a database (see Fig.1, #106 and col.4, lines 61-67) including work activity values for work activities of the employee in the profile and a database including a directory of work activities used to create the profile (see col.4, lines 24-51 and col.5, lines 1-10). (**Note:** By employing another database does not necessitate an invention, for optimization, databases are added or replaced with larger databases, according to memory requirements and cost, and the allocation of data within that database can be segmented as desired, therefore the addition of another database does not change the functionality of the claimed invention.)

As per claim 7, Skinner further teaches wherein the profile contains a plurality of groups of work activities (see col.3, lines 49-56 and col.4, lines 29-32).

As per claims 8, 19, and 27, Skinner further teaches wherein the employee assigns a percentage of the employee's time to each group of work activities in the profile (see col.1, lines 38-40; col.4, lines 39-43; and col.16, line 46 to col.17, line 20).

As per claim 9, Skinner further teaches wherein a work activities group value is calculated for each group of work activities (see col.3, lines 14-18 and col.5, lines 54-57).

As per claims 14, 15, 23 and 24, Skinner teaches of further comprising adding and deleting work activities of the employee to the profile (see col.3, lines 37-18 & lines 49-53 and col.4, lines 40-41).

As per claims 16 and 25, Skinner does not teach of further comprising providing a template for the employee to create the profile. Sanders teaches of providing a template for creating a profile (see col.7, lines 12-18: "field feedback survey"). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Sanders within the system of Skinner by implementing a template for creating a profile within the work activities obtaining method because such an implementation provides for a user-friendly means and increases acceptance as well as decreasing cost for training.

As per claims 19 and 26, Skinner teaches of further comprising, assessing a capability of the employee with respect to the work activities in the profile (see col.2, lines 3-4 & lines 57-62).

4. Claims 10, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 5,963,914 A) and Sanders (US 6,411,936 B1), and further in view of Paizis (US 6,338,042 B1).

As per claims 10 and 20, Skinner and Sanders do not explicitly teach wherein the work activities group values for the groups of work activities are weighted to calculate the market valuation for the profile. Paizis teaches of work activities group values for the groups of work activities are weighted (see col.5, lines 43-47). It would have been

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obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Paizis within the system of Skinner and Sanders by implementing weighted work activities of groups within the work activities obtaining method because Paizis teaches that there are other factors such as "external market distribution data" that more accurately determines performance ranking and clearly pay scales differ significantly by different positions, functions, and departments.

As per claim 17, Skinner and Sanders do not explicitly teach of further comprising, converting the market valuation for the profile to a local geographic equivalent value. Paizis teaches of converting market valuation for the profile to a local geographic equivalent value (see col.5, lines 43-47 and col.8, lines 30-32). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Paizis within the system of Skinner and Sanders by implementing calculating a market valuation that is converted according to geography within the work activities obtaining method because Paizis teaches that there are other factors such as "external market distribution data" that more accurately determines performance ranking and clearly pay scales differ significantly across the country as well as across different countries.



***Response to Arguments***

5. Applicant's arguments filed September 7, 2004 have been fully considered and in light of the Interview conducted on August 26, 2004, the Paizis (US 6338042 B1) reference was eliminated from the rejection of independent claims 1, 11, 12, 21, 28, 30, 32 and 34. However, as a result of further searching and careful analysis, a new reference, Sanders (US 6,411,936 B1), has been provided to teach the deficiencies that which neither Skinner et al. (US 5963914A) nor Paizis (US 6338042 B1) taught.

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

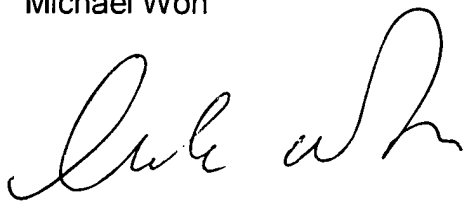
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won

A handwritten signature in black ink, appearing to read 'Michael Won'.

December 2, 2004

A handwritten signature in black ink, appearing to read 'Hosain Alam'.

**HOSAIN ALAM**  
**SUPERVISORY PATENT EXAMINER**